

layer is attachable to a second side of the stock member.

2. The label of claim 1, wherein the second layer includes an adhesive on an outer surface of the second layer.

3. The label of claim 1, wherein the gap comprises a series of perforations.

4. The label of claim 1, wherein the gap comprises a section of complete separation between each of the two or more second layer sections.

5. The label of claim 1, wherein the gap comprises a discontinuity in the second layer.

6. The label of claim 1, wherein the fold-line section is offset from a centerline of the first layer.

7. The label of claim 1, wherein the second layer has at least two gaps and wherein the label is foldable upon a three dimensional tab member.

C2 8. (Previously Twice Amended) The label of claim 1, wherein the second layer has a thickness wherein neither the first section nor the second section of the second layer bend substantially when the folding pressure is applied to the label.

9. The label of claim 1, wherein the second layer comprises a material which is darker than the material of the first layer.

10. The label of claim 9, wherein the gap is discernible through the first layer.

11. A label comprising:
a first layer; and

a second layer attached to the first layer and having at least two sections at least partially separated by a gap, the gap being discernible through the first layer, the second layer having an adhesive on an outer surface for applying the label to a stock member having at least two surfaces;

wherein the label folds along the discernible gap such that the at least two sections are mountable on different surfaces of the stock member when the label is applied over an edge of the stock member.

C3 12. (Previously Once Amended) The label of claim 11, wherein the second layer comprises a lighter material than the first layer.

13. The label of claim 11, wherein the second layer comprises a darker material than the first layer.

14. The label of claim 13, wherein the second layer comprises a security label material.

15. The label of claim 11, wherein the gap indicates a label fold-line for matching with the edge of the stock member.

16. The label of claim 11, wherein the gap defines a fold-line section in the first layer.

17. The label of claim 16, wherein the first layer folds along the fold-line section when a folding force is applied to the label.

18. The label of claim 11, wherein the gap comprises a series of perforations.

19. The label of claim 11, wherein the gap comprises a section of complete separation between each of the two or more second layer sections.

20. The label of claim 11, wherein the gap is offset from a centerline of the first layer.
21. The label of claim 11, wherein the second layer has at least two gaps and wherein each gap is visible through the first layer.
22. A label comprising:
a first layer having a top surface adapted to being printed on and a bottom surface; and
a second layer attached to the bottom surface of the first layer, the second layer comprising two or more sections, wherein between each of the two or more sections is a gap, each gap defining a fold-line section in the first layer, the second layer comprising a darker material than the first layer, wherein each gap is discernible through the first layer and indicates the fold-line section of the first layer, the first layer folds along the fold-line section when a folding force is applied to the label.
23. The label of claim 22, wherein the second layer comprises a security label material.
24. The label of claim 22, wherein the gap comprises a series of perforations.
25. The label of claim 22, the gap comprises a section of separation between each of the two or more second layer sections.
26. (Three Times Amended) A label form comprising:
a backing member;
a first layer having a top surface adapted to being printed on; and
a second layer including a non-adhesive label material which is permanently attached to the first layer and removably attached to the backing member and located between the first layer and the backing member, the [second layer comprising] non-adhesive label material having at least two sections having a gap therebetween, wherein the first layer has a foldable section located along the gap of the second layer;
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wherein, when the label has been removed from the backing member and a folding pressure is applied to the label, the label folds along the foldable section such that one section of the second layer is attachable to a first side of the stock member and a second section of the second layer is attachable to a second side of the stock member.

27. The label form of claim 26, wherein the first layer includes one or more label members, each label member attached to at least two sections of the second layer.

28. The label form of claim 27, wherein each of the one or more label members includes a perimeter edge which matches an edge of the at least two sections of the second layer attached to the label member.

29. The label form of claim 26, wherein the second layer comprises a security label material.

30. A method of applying a label to an edge of a stock member, the method comprising:
aligning the label such that a discernible gap of the label is aligned with an edge of the stock member;
applying a first portion of the label to a first side of the edge of the stock member;
folding the label along the discernible gap which is defined by a weakened fold-line running along a surface of the label, the weakened fold-line located between the first portion of the label and a second portion of the label; and
applying the second portion of the label to a second side of the edge of the stock member.

31. The method of claim 30, wherein the discernible gap is discernible through a first layer of the label.

32. A method of applying a label to an edge of a stock member, the method comprising:
providing a label having a first layer having a top surface adapted to being printed on and a bottom surface, the label also having a second layer attached to the bottom surface of the first

layer, the second layer comprising two or more sections, wherein between each of the two or more sections is a gap, the gap defining a visually discernible fold-line section in the first layer, the first layer folds along the fold-line section when a folding force is applied to the label;
applying a first portion of the label to a first side of the edge of the stock member;
folding the label along the fold-line section; and
applying a second portion of the label to a second side of the edge of the stock member.

33. The method of claim 32 wherein, the second layer comprises a darker material than the first layer.

34. A label comprising:
a first layer; and
a second layer permanently attached to the first layer and having an adhesive on an outer surface of the second layer, the second layer including a first section and a second section at least partially separated by a gap which is visually discernible through the first layer, wherein the label folds along the visually discernible gap such that a user folding the label can predict where the label will fold by perceiving the visually discernible gap through the first layer.

REMARKS

Applicant has reviewed and considered the Office Action mailed on August 27, 2002, and the references cited therewith.

Claims 1 and 26 are amended; claims 1-34 are now pending in this application.

§103 Rejection of the Claims

Claims 1-34 were rejected under 35 USC § 103(a) as being unpatentable over Cunningham (U.S. 2,893,144) in view of Verhines (U.S.5,996,130).

Claims 1-10

Applicant has amended claim 1 to better describe the subject matter recited in the claim. Applicant believes that the amended claim is not obvious in view of the cited references since,

even if combined, the cited references do not teach the subject matter claimed nor is there any motivation to modify either reference to include such subject matter.

Cunningham is directed to index tabs having two sections (13 and 14) mounted onto an adhesive strip 11. (Figures 2 and 5, Cunningham). Verhines discusses a tab having a tab material 74 with two adhesive sections 82 and 90. If Cunningham were modified by Verhines, the Cunningham tab would merely have a gap in the adhesive on layer 11, but the combination would not include each limitation recited in the claim. For instance, the combination would not provide a "second layer including a non-adhesive label material" which is permanently attached to the second surface of the first layer, the second layer having an adhesive on an outer surface of the non-adhesive label material, "the non-adhesive label material of the second layer having a first section and a second section having a gap therebetween," as recited in claim 1.

Moreover, the Verhines reference does not even fold along its adhesive gap 78, so there is no motivation to even combine the references for that reason. The Verhines reference deals with a tab 74 which, in use, is already connected to sheet 62. The tab is configured such that a user can unfold and re-attach the tab after the sheet has gone through a printer. This leads away from the present claim which is directed to a label including a first layer and a second layer having a gap defining a fold-line section in the first layer, "wherein when a folding pressure is applied to the label, the label folds along the fold-line section." This type of folding label is not discussed or suggested by the Verhines reference, which folds along a fold-line 114, and not along a gap when a folding pressure is applied.

Claims 2-10 include each limitation of parent claim 1 and are therefore also not obvious in view of the cited references.

Moreover, regarding claim 10, which recites "wherein the gap is discernible through the first layer," the Office Action states that it "would have been obvious to ... provide any desired material having different characteristics such as color depending on the desired end result, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice." Applicant again traverses this matter-of-design-choice rejection. The Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine or modify

reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2D 1430 (Fed. Cir. 2002). The present rejection is a mere conclusory statement of subjective belief, so Applicant respectfully submits that the Office Action has not provided objective evidence for a suggestion or motivation to modify the reference.

Also, the recited limitation is discussed in the present application at page 6, lines 8-9, where it is discussed that the discernible gap allows the label to be visually aligned with the edge of a stock member when a user is applying the label. The discernible gap of the claimed label allows the user to predict where the label will fold and this allows the user to align the label without having to look at the back of the label each time to see where it will fold. Since the limitation has been pointed out to provide an advantage over the prior art, Applicant believes the present rejection is not supported under MPEP 2144.04, which states “[i]f the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection.” Reconsideration and allowance is respectfully requested.

Claims 11-21

Applicant traverses the obviousness rejection of claim 11. Applicant respectfully submits that the Office Action has not make out a *prima facie* case of obviousness since neither reference teaches or suggest all of the elements of applicant’s claim. Applicant notes that to support a *prima facie* case of obviousness, the reference must teach or suggest all the claim elements. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Claim 11 is directed to a label having first and second layers where the second layer includes “at least two sections at least partially separated by a gap, the gap being discernible through the first layer,” wherein “the label folds along the discernible gap such that the at least two sections are mountable on different surfaces of the stock member when the label is applied over an edge of the stock member.” This allows to be visually aligned with the edge of a stock member when a user is applying the label. The discernible gap of the claimed label allows the user to predict where the label will fold and this allows the user to align the label without having

to look at the back of the label each time to see where it will fold.

As admitted by the Office Action, neither reference discusses a gap being discernible through the first layer. However, as noted above the Office Action states that it “would have been obvious to ... provide any desired material having different characteristics such as color depending on the desired end result, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice.” Applicant traverses this matter-of-design-choice rejection. Again, the Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine or modify reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2D 1430 (Fed. Cir. 2002). The present rejection is a mere conclusory statement of subjective belief, so Applicant respectfully submits that the Office Action has not provided objective evidence for a suggestion or motivation to modify the reference.

As discussed above, the recited limitation is discussed in the present application at page 6, lines 8-9, where it is discussed that the discernible gap allows the label to be visually aligned with the edge of a stock member when a user is applying the label. The discernible gap of the claimed label allows the user to predict where the label will fold and this allows the user to align the label without having to look at the back of the label each time to see where it will fold. Since the limitation has been pointed out to provide an advantage over the prior art, Applicant believes the present rejection is not supported under MPEP 2144.04, which states “[i]f the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection.”

Claims 12-21 include each limitation of parent claim 11 and are therefore also not obvious over the cited references for the reasons stated above. Moreover, applicant traverses the Examiner’s reliance on case law to support the obviousness rejection of claims 12 and 13 “as a matter of design choice,” for the reasons stated above for claim 11. Reconsideration and allowance is respectfully requested.

Claims 22-25

Claim 22 includes similar limitations as claim 11 and is not obvious over the cited references for similar reasons as discussed above for claim 11. The discussion for claim 11 above is incorporated herein by reference.

Claims 23-25 include each limitation of parent claim 22 and are therefore also not obvious over the cited references. Reconsideration and allowance is respectfully requested.

Claims 26-29

Claim 26 has been amended in a similar manner as claim 1, and the discussion for claim 1 is incorporated herein by reference. Claims 27-29 include each limitation of parent claim 26 and are therefore also not obvious over the cited references. Reconsideration and allowance is respectfully requested.

Claims 30-31

Claim 30 includes similar limitations as claim 11 and is not obvious over the Verhines reference for similar reasons as discussed above for claim 11. For instance, claim 30 recites “aligning the label such that a discernible gap of the label is aligned with an edge of the stock member,” applying a first portion of the label to a first side of the edge of the stock member, and “folding the label along the discernible gap” which is defined by a weakened fold-line running along a surface of the label. Again, Applicant submits that since the discernable gap limitation provides advantages as described in the application, it is not permissible to rely on a rationale based on matter of design choice. The discussion for claim 11 is incorporated herein by reference. Reconsideration and allowance is respectfully requested.

Claims 32-33

Claims 32-33 contain similar elements as claims 11 and 30 and are not obvious over the cited references for similar reasons as discussed above for those claims, the discussion of which is incorporated herein by reference. Reconsideration and allowance is respectfully requested.

Claim 34

Claim 34 includes similar limitations as claim 11 and is not obvious over the cited references for similar reasons as discussed above for claim 11. For instance, claim 34 recites a label which includes "a second layer including a first section and a second section at least partially separated by a gap which is visually discernible through the first layer, wherein the label folds along the visually discernible gap such that a user folding the label can predict where the label will fold by perceiving the visually discernible gap through the first layer." The discussion for claim 11 is incorporated herein by reference. Reconsideration and allowance is respectfully requested.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, Peter Maki, at (612-359-3267) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 18 day of December, 2002.

Candis B. Buending

Name

Signature



CLEAN VERSION OF PENDING CLAIMS

1. (Three Times Amended) A label for attaching over an edge of a stock member, the label comprising:
a first layer having a first surface adapted to being printed on and a second surface; and
a second layer including a non-adhesive label material which is permanently attached to the second surface of the first layer, the second layer having an adhesive on an outer surface of the non-adhesive label material, the non-adhesive label material of the second layer having a first section and a second section having a gap therebetween, said gap defining a fold-line section in the first layer, the second layer covering substantially all of the second surface of the first layer except for the fold-line section, wherein when a folding pressure is applied to the label, the label folds along the fold-line section such that the first section of the second layer is attachable to a first side of the stock member and the second section of the second layer is attachable to a second side of the stock member.

2. The label of claim 1, wherein the second layer includes an adhesive on an outer surface of the second layer.

3. The label of claim 1, wherein the gap comprises a series of perforations.

4. The label of claim 1, wherein the gap comprises a section of complete separation between each of the two or more second layer sections.

5. The label of claim 1, wherein the gap comprises a discontinuity in the second layer.

6. The label of claim 1, wherein the fold-line section is offset from a centerline of the first layer.

7. The label of claim 1, wherein the second layer has at least two gaps and wherein the label is foldable upon a three dimensional tab member.

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8. (Previously Twice Amended) The label of claim 1, wherein the second layer has a thickness wherein neither the first section nor the second section of the second layer bend substantially when the folding pressure is applied to the label.
9. The label of claim 1, wherein the second layer comprises a material which is darker than the material of the first layer.
10. The label of claim 9, wherein the gap is discernible through the first layer.
11. A label comprising:
a first layer; and
a second layer attached to the first layer and having at least two sections at least partially separated by a gap, the gap being discernible through the first layer, the second layer having an adhesive on an outer surface for applying the label to a stock member having at least two surfaces;
wherein the label folds along the discernible gap such that the at least two sections are mountable on different surfaces of the stock member when the label is applied over an edge of the stock member.
12. (Previously Once Amended) The label of claim 11, wherein the second layer comprises a lighter material than the first layer.
13. The label of claim 11, wherein the second layer comprises a darker material than the first layer.
14. The label of claim 13, wherein the second layer comprises a security label material.
15. The label of claim 11, wherein the gap indicates a label fold-line for matching with the edge of the stock member.
16. The label of claim 11, wherein the gap defines a fold-line section in the first layer.

17. The label of claim 16, wherein the first layer folds along the fold-line section when a folding force is applied to the label.
18. The label of claim 11, wherein the gap comprises a series of perforations.
19. The label of claim 11, wherein the gap comprises a section of complete separation between each of the two or more second layer sections.
20. The label of claim 11, wherein the gap is offset from a centerline of the first layer.
21. The label of claim 11, wherein the second layer has at least two gaps and wherein each gap is visible through the first layer.
22. A label comprising:
 - a first layer having a top surface adapted to being printed on and a bottom surface; and
 - a second layer attached to the bottom surface of the first layer, the second layer comprising two or more sections, wherein between each of the two or more sections is a gap, each gap defining a fold-line section in the first layer, the second layer comprising a darker material than the first layer, wherein each gap is discernible through the first layer and indicates the fold-line section of the first layer, the first layer folds along the fold-line section when a folding force is applied to the label.
23. The label of claim 22, wherein the second layer comprises a security label material.
24. The label of claim 22, wherein the gap comprises a series of perforations.
25. The label of claim 22, the gap comprises a section of separation between each of the two or more second layer sections.

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26. (Three Times Amended) A label form comprising:
a backing member;
a first layer having a top surface adapted to being printed on; and
a second layer including a non-adhesive label material which is permanently attached to the first layer and removably attached to the backing member and located between the first layer and the backing member, the non-adhesive label material having at least two sections having a gap therebetween, wherein the first layer has a foldable section located along the gap of the second layer; wherein, when the label has been removed from the backing member and a folding pressure is applied to the label, the label folds along the foldable section such that one section of the second layer is attachable to a first side of the stock member and a second section of the second layer is attachable to a second side of the stock member.

27. The label form of claim 26, wherein the first layer includes one or more label members, each label member attached to at least two sections of the second layer.

28. The label form of claim 27, wherein each of the one or more label members includes a perimeter edge which matches an edge of the at least two sections of the second layer attached to the label member.

29. The label form of claim 26, wherein the second layer comprises a security label material.

30. A method of applying a label to an edge of a stock member, the method comprising:
aligning the label such that a discernible gap of the label is aligned with an edge of the stock member;
applying a first portion of the label to a first side of the edge of the stock member;
folding the label along the discernible gap which is defined by a weakened fold-line running along a surface of the label, the weakened fold-line located between the first portion of the label and a second portion of the label; and
applying the second portion of the label to a second side of the edge of the stock member.

31. The method of claim 30, wherein the discernible gap is discernible through a first layer of the label.
32. A method of applying a label to an edge of a stock member, the method comprising:
providing a label having a first layer having a top surface adapted to being printed on and a bottom surface, the label also having a second layer attached to the bottom surface of the first layer, the second layer comprising two or more sections, wherein between each of the two or more sections is a gap, the gap defining a visually discernible fold-line section in the first layer, the first layer folds along the fold-line section when a folding force is applied to the label;
applying a first portion of the label to a first side of the edge of the stock member;
folding the label along the fold-line section; and
applying a second portion of the label to a second side of the edge of the stock member.
33. The method of claim 32 wherein, the second layer comprises a darker material than the first layer.
34. A label comprising:
a first layer; and
a second layer permanently attached to the first layer and having an adhesive on an outer surface of the second layer, the second layer including a first section and a second section at least partially separated by a gap which is visually discernible through the first layer, wherein the label folds along the visually discernible gap such that a user folding the label can predict where the label will fold by perceiving the visually discernible gap through the first layer.